

### **REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the pending claims and the following remarks.

#### ***Amendments to the Claims***

Upon entry of the present amendment, claims 1-5 and 7-16 will be pending in the present application. Claim 6 has been cancelled herein. Claims 1, 3 and 4 have been amended. Claims 9-16 have been added.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, the amendment to claim 1 finds support in claim 6 as originally filed as well as page 7, lines 10-12 of the present specification. Claims 3-4 have been amended to change their dependency from "Claims 1 or 2" to "Claim 1."

Support for new claim 9 can be found in the specification, *inter alia*, at page 11, lines 8-19. Support for new claim 10 can be found in the specification, *inter alia*, at page 11, lines 20-22. Support for new claim 11 can be found in the specification, *inter alia*, at page 12, line 15 to page 13, line 1. Support for new claim 12 can be found in the specification, *inter alia*, at page 13, lines 8-13 as well as page 14, lines 6-13. Support for new claim 13 can be found in the specification, *inter alia*, at page 15, lines 7-19. Support for new claims 14-15 can be found in the specification, *inter alia*, at page 9, lines 21-23 as well as page 10, lines 4-9. Support for new claim 16 can be found in the specification, *inter alia*, at page 10, lines 9-11.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Issues over the Prior Art***

1) The Examiner has rejected claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Freedman '782 (US 5,186,782).

Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

Applicants have noted pages 2-3 of the outstanding Office Action.

As amended, independent claim 1 recites, *inter alia*:

*wherein the film has been prepared by co-extruding back and front layers with a core layer and drawing the coextrudate, wherein each of the front layer, the core layer, and the back layer independently comprises a heat-shrinkable film layer* (emphasis added).

In stark contrast, these two technical features are not described in Freedman '782.

In view of the above, Applicants respectfully submit that the present invention is novel and nonobvious over Freedman '782. Thus, withdrawal of the rejection is respectfully requested.

2) The Examiner has rejected claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Chu et al. '844 (US 7,306,844). Applicants respectfully traverse the rejection, and reconsideration is based on the following remarks.

Applicants claim benefit of foreign priority on JP 2003-119400 and JP 2003-284765. Applicants have filed herewith a verified English translation of the foreign priority documents have filing dates of April 24, 2003 and August 1, 2003, respectively. The foreign priority documents support the invention as presently claimed.

Applicants have perfected a claim to priority under 35 U.S.C. § 119, and the foreign priority dates antedate the filing date of Chu et al. '844. As such, the cited reference cannot be considered prior art, and withdrawal of the rejection is respectfully requested.

3) The Examiner has rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Chu et al. '844 in view of Argoitia et al. '936 (US 6,749,936). Applicants respectfully traverse the rejection, and reconsideration is based on the following remarks.

As described above, Applicants have perfected a claim to priority under 35 U.S.C. § 119, and the foreign priority dates antedate the filing date of Chu et al. '844. As such, Chu et al. '844 cannot be considered prior art, and the rejection fails. Accordingly, withdrawal of the rejection is respectfully requested.

4) The Examiner has rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Freedman '782 in view of Argoitia et al. '936. Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

As discussed above, Freedman '782 does not disclose each and every aspect of claim 1, from which the other pending claims ultimately depend. Applicants respectfully submit that Argoitia et al. '936 do not overcome the deficiencies of this reference.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, Freedman '782 fails to teach or suggest all the claims limitations of independent claim 1, and those claims dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Moreover, the object of Freedman '782 is to provide a method for high-speed labeling of deformable substrates such as a squeeze bottle and the like as well as to manufacture film facestocks usable in the method. Freedman '782 does not disclose the structure to be the same as the present invention since the label certainly comprises an adhesive layer.

Since the film is annealed or heat-set after the hot stretch operation, Freedman '782 differs in this respect from "shrink" films of the present invention.

Argoitia et al. '936 disclose neither the object nor structure of the present invention. Thus, one of ordinary skill in the art would not have found the present invention to be obvious over the combination of Freedman '782 and Argoitia et al. '936.

Moreover, relevant to this § 103(a) rejection, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467. In this regard, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. *See In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). Also, the comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. *See* MPEP 716.02(b) and 716.02(c).

In this regard, Applicants note MPEP 2144.08(5)(B), which states that rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

According to the present invention, the following pronounced effects are provided since the front layer 1, the core layer 2, and the back layer 3 are constituted as heat-shrinkable film layers (page 18, lines 4-18):

(i) The three layers can be formed by the easy and convenient procedure of coextrusion, heat-shrinkability can be imparted by subjecting the extruded three layers to drawing simultaneously, and the heat-shrinkable opaque white film can thereby be produced with high production efficiently.

(ii) If a printing process such as gravure printing is employed, the present invention prevents a heat-shrinkable film layer from being dissolved or deteriorated with a solvent in ink, and the film layer is easy to have a sufficiently high whiteness and does not require higher cost.

(iii) When a preprinted layer is highly shrunk, the present invention can prevent ink cracking and a deteriorated appearance.

Thus, for the additional reason that the present invention achieves unexpected results, this rejection has been overcome.

For the reasons given above, reconsideration and withdrawal of this rejection are respectfully requested.

***Newly Proposed Claims 9-16***

Applicants have newly proposed claims 9-16 in an effort to further define the scope of protection owed to Applicants. Applicants respectfully submit that claims 9-16 are allowable for the reasons given above. As such, Applicants respectfully assert that claims 9-16 clearly define over the prior art of record, and an early indication to this effect is earnestly solicited.

**CONCLUSION**

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink (Reg. No. 58,258) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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Attachments: Certified English translations of JP 2003-119400 and JP 2003-284765.